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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,889	03/26/2004	Yoshifumi Tanimoto	042089	7798
38834 7590 11/06/2008 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036				
EXAMINER				
SAMS, MATTHEW C				
ART UNIT		PAPER NUMBER		
2617				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/809,889

Applicant(s)

TANIMOTO, YOSHIFUMI

Examiner

MATTHEW SAMS

Art Unit

2617

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/15/2008 has been entered.
2. Claim 13 has been amended.

Response to Arguments

3. Applicant's arguments with respect to claim 13 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 13-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 13 states “transmitting an instant message including identification information of the terminal of the forwarding destination from the terminal of the forwarder to a communication device and not to the instant message server, when the user of the forwarding destination is not logged in the instant message server”, however the specification states on Page 7 that “When the second client terminal 16b is not under the active status, the first client terminal 16a transmits the instant message to the communication device 100 via the IM server 14”.

Therefore, the specification does not support a direct transmission from the terminal of the forwarder to the communication device, but rather from the terminal of the forwarder to the IM server and then to the communication device. This is how the examiner is interpreting the claims.

Claims 14-19 are rejected for inheriting the defects of independent claim 13.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al. (US-2003/0182428 hereinafter, Li) in view of Dorenbosch et al. (US-2002/0173308 hereinafter, Dorenbosch).

Regarding claim 13, Li teaches a communication method comprising the steps of:

detecting by a terminal of a forwarder, whether or not a user of a terminal of a forwarding destination is logged in an instant message server; (Page 2 [0010] *i.e.* "the resulting P2P communication service/network allows users to remain aware of others' online/offline statuses")

transmitting an instant message including identification information of the terminal of the forwarding destination from the terminal of the forwarder to a communication device when the user of the forwarding destination is not logged in the instant message server; (Page 8 [0105])

storing the instant message received from the terminal of the forwarder in means for storing of the communication device; (Fig. 3 [340 & 348])

detecting by the communication device, whether or not the user of the forwarding destination designated as the terminal of the forwarding destination is logged in the instant message server; (Page 2 [0010]) and

transmitting the instant message stored in the means for storing from the communication device to the terminal of the forwarding destination when the user of the forwarding destination logs into the instant message server; (Page 8 [0105])

wherein when the user of the forwarding destination logs in (Page 7 [0094]), the buffered messages saved for the forwarding destination address are transmitted to the destination when a connection is established. (Page 8 [0105])

Li differs from the claimed invention by not explicitly reciting the forwarding destination information corresponding to the logged-in user of the forwarding destination is extracted from a forwarding destination column of the stored instant message, the extracted forwarding destination information is set as a destination, and the instant message is transmitted to the terminal of the set destination.

However, Li teaches typically, instant messages are routed through an IM server (*i.e.* originally addressed to a server...) to get to the respective target destination. (...which forwards the message to the target buddy Page 6 [0078] and Fig. 3 [300] *i.e.* the user interface [302] is used to generate the instant message, then the message is sent to the function logic layer [304] for either storage [330] or processing [322, 324 or 326] by the dedicated server Page 7 [0090] prior to determining the optimal route [350] to the destination peer computer [102])

Although Li does not explicitly recite "extracting" [a forwarding destination from a] "forwarding destination column", it is obvious to one of ordinary skill in the art that the instant message is required to be routed through a IM server (Fig. 3 [314, 306 & 350], Page 4 [0038], Page 6 [0076] and Page 7 [0090] *i.e.* regardless of whether the communication system model is implemented in the peer computer or in a dedicated server) and that the forwarding destination column is analogous to the buddy user information (Fig. 4 [400]), which is analyzed by the system in order to forward the

buffered instant message to the correct mobile subscriber when a connection is reestablished between user and the peer-to-peer network. (Page 7 [0090] & Page 8 [0105])

Further, it is obvious that one of ordinary skill in the art would have been motivated to implement the use of a dedicated server device for logic layers (Fig. 3 [304 & 306]) because it takes the burden of determining when a destination peer computer is available for receiving a delayed sending task away from the peer computer storing the message. (Page 7 [0090] and Fig. 3 [330])

Li teaches storing an instant message for a user that is offline at an IM server (Fig. 3 [348], Page 6 [0076], Page 7 [0090] and Fig. 2A [106]), but differs from the claimed invention by not explicitly reciting the transmission of an instant message from the terminal of the forwarder to the IM server and then to the communication device for storage when the user of the forwarding destination is not logged in the instant message server.

In an analogous art, Dorenbosch teaches transmitting an instant message from a terminal of the forwarder (Fig. 1 [14]) to the IM server (Fig. 1 [20 & 22]) and then to the communication device (Fig. 1 [24]) for storage when the user (Fig. 1 [12]) of the forwarding destination is not accessible to the instant message server. (Fig. 1 [20] and Pages 3-4 [0033]) At the time the invention was made, it would have been obvious to one of ordinary skill in the art to implement the communication method of Li after modifying it to incorporate the IM proxy of Dorenbosch. One of ordinary skill in the art would have been motivated to do this since Dorenbosch enables instant messaging for

mobile subscribers which can be a more convenient/user friendly method of communication for users. (Page 1 [0002-0005])

Regarding claim 14, Li in view of Dorenbosch teaches an instant message proxy for a communication method in a mobile environment that includes adding to an instant message to be transmitted from the communication device to the terminal of the forwarding destination, transmitter information included in the instant message which the communication device received from the terminal of the forwarder. (Dorenbosch Fig. 3, Page 2 [0021] and Page 3 [0032])

Regarding claim 15, Li in view of Dorenbosch teaches the step of transmitting, when a prescribed period of time elapses after the communication device receives the instant message from the terminal of the forwarder, an instant message indicating such a fact from the communication device to the terminal of the forwarder. (Dorenbosch Fig. 4 [56 & 58] and Page 2 [0023])

Regarding claim 16, Li in view of Dorenbosch teaches the step of transmitting the instant message from the terminal of the forwarder to the terminal of the forwarding destination without intervening the communication device when the user of the forwarding destination is logged in the instant message server. (Dorenbosch Page 2 [0020] through Page 3 [0027])

Regarding claim 17, Li in view of Dorenbosch teaches a means for detecting whether or not the user is logged in server. (Dorenbosch Page 2 [0023])

Regarding claim 18, Li in view of Dorenbosch teaches receiving a first instant message including a transmission destination, a transmitter, a forwarding destination

and main text form the terminal of the forwarder. (Dorenbosch Fig. 2 [24], Fig. 3 [43] and Page 2 [0020-0023])

Regarding claim 19, Li in view of Dorenbosch teaches a means for generating a second instant message including a transmission destination, a transmitter, a forwarder and main text as an instant message to be transmitted to the terminal of the forwarding destination in accordance with the first instant message. (Dorenbosch Fig. 2 [24], Fig. 3 [43], Page 2 [0020-0023] and Page 3 [0032])

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW SAMS whose telephone number is (571)272-8099. The examiner can normally be reached on M-F 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on (571) 272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George Eng/
Supervisory Patent Examiner, Art Unit 2617

MCS
11/4/2008